

Attorney Docket: 015.P012

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REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Claims 1-33 are currently pending. Claims 1, 5-8 and 29 stand rejected under 35 USC § 103 over US Patent No. 6,044,469 of Horstmann (hereinafter Horstmann) in view of the article titled "Amino Communications" (hereinafter Amino), in further view of US Patent No. 6,157,721 of Shear et al. (hereinafter Shear). Claims 2-4, 9-28, and 30-33, stand rejected under 35 USC § 103 over Horstmann, in view of Amino, in further view of Shear, and in further view of US Patent No. 5,991,399 of Graunke et al. (hereinafter Graunke). Claims 12, 16, 17, and 27 have been amended to correct minor typographical issues. For example, claim 12 has been amended to remove an extraneous use of the term "and," along with an extraneous use of the term "rendering." While in claims 16, 17, and 27 have been amended to add a colon for punctuation reasons. It is respectfully asserted that these amendments do not narrow the scope of claimed subject matter and therefore should not result in any prosecution history estoppel. New claims 34-42 have been added. No new matter has been presented. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

With regard to the Examiner's rejection of claim 1, Assignee respectfully asserts that the Examiner has failed to establish a prima facie case of unpatentability under 35 USC § 103. As is well established, prima facie rejection under Section 103, three requirements must be met. First, there must be some suggestion or motivation, either in the cited documents themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the document(s) or to combine document teachings. Second, there must be a reasonable expectation of success. Finally, the cited document(s) (or documents when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on assignee's

disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2142, 2143 - § 2143.03 for decisions pertinent to each of these criteria. It is respectfully asserted that these requirements are not met here.

More specifically, the Examiner has failed to establish a prima facie case of unpatentability because the cited documents do not teach each and every element of Assignee's claim 1. For Example, contrary to the Examiner's assertion Horstmann does not teach "a tamper resistant digital content recovery module to recover protected digital contents of various types in an obfuscated manner;" or a "a plurality of plain text digital content rendering modules communicatively coupled with each other in a hierarchical manner forming a hierarchy of modules" as recited by Assignee claim 1. The Examiner incorrectly asserts that column 5, lines 54-59, of Horstmann teaches "a plurality of plain text digital content rendering modules communicatively coupled with each other in a hierarchical manner forming a hierarchy of modules," as recited by Assignee's claim 1. However, Assignee would like to respectfully note that the cited portion of Horstmann makes no mention of "a plurality of plain text digital content rendering modules" or "a hierarchy of modules." Instead, the cited portion of Horstmann states "Referring more particularly to FIG. 5, the Protector 103 with which the executable is injected is preferably a standard code module that does not vary from product to product. When the Protector 103 is run, it goes down a checklist, running code for each protection measure selected by the publisher." The cited portion of Horstmann only mentions a single module, "the Protector 103 ... is preferably a standard code module," as such Assignee respectfully asserts that Horstmann does not teach "a plurality of plain text digital content rendering modules communicatively coupled with each other in a hierarchical manner forming a hierarchy of modules" as recited by Assignee's claim 1. Even if the combination of cited documents was appropriate, which, as discussed more fully below, Assignee does not concede, the remaining cited documents do not cure the above referenced deficiency in the teaching of Horstmann. For

at least these reasons, Assignee respectfully asserts that the Examiner's rejection of claim 1 has been traversed and respectfully requests that the rejection be withdrawn.

The Examiner, in response to Assignee's earlier arguments, asserts that "the Protection module of Horstmann is a tamper resistant module by calculating a checksum or cryptographic fingerprint." (citations omitted). Assignee respectfully disagrees with the Examiner's characterization of the cited portion of Horstmann. Specifically, the cited portion of Horstmann states "[w]henver the software product is used, the Protector 103 calculates the checksum (or cryptographic fingerprint) of the original license file. If the checksums are different, use is disallowed." The Examiner has asserted that Protector 103 teaches "a tamper resistant digital content recovery module to recover protected digital contents of various types in an obfuscated manner," as recited in Assignee's claim 1. Assignee respectfully asserts that the cited portion does not teach or suggest a "tamper resistant digital content recovery module" as that term is used in Assignee's claim 1 because Horstmann does not teach or suggest that Protector 103 is itself a tamper resistant module. In light of this, Assignee respectfully asserts that the Examiner has failed to Establish a prima facie case of unpatentability under 35 USC § 103 because the cited documents, alone or in combination, do not teach or suggest the above-cited portion of Assignee's claim 1. Therefore, Assignee respectfully requests that this ground for rejection be withdrawn.

With regard to claim 2, Assignee respectfully asserts that the cited documents, alone or in combination, do not reach or suggest an apparatus "wherein the tamper resistant digital content recovery module is equipped to verify the plain text digital content rendering module occupying the root position of the hierarchy as not having been compromised, and to provide recovered digital content to the plain text digital content rendering module occupying the root position of the hierarchy, only upon having verified the plain text digital content rendering module occupying

the root position of the hierarchy as not having been compromised," as recited by Assignee's claim 2. For example, the Examiner asserts that Graunke teaches a system that "determines in the system is a trust worthy player (software) before providing the user with the key and therefore access to digital content. In the case that the player is compromised the player does not have the ability to perform the cryptographic operation." (citations omitted). However, it is respectfully asserts that the cited portion of Graunke makes no mention of a root module, much less an apparatus "wherein the tamper resistant digital content recovery module is equipped to verify the plain text digital content rendering module occupying the root position of the hierarchy as not having been compromised," as recited by Assignee's claim 2. In light of this it is respectfully asserted that this ground of rejection has been traversed. Therefore, Assignee respectfully requests that this rejection be withdrawn.

With regard to claim 5, Assignee respectfully asserts that the documents cited by the Examiner, alone or in combination do not teach or suggest an apparatus "wherein the hierarchy of modules includes a module occupying a non-leaf position in the hierarchy and a module occupying an immediate downstream position in the hierarchy from the non-leaf plain text digital content rendering module, and the non-leaf module is equipped to verify the immediate downstream module as not having been compromised," as recited by Assignee's claim 5. The portion of Shear cited by the Examiner states that "A hierarchy of assurance levels may be provided for different protected processing environment security levels," but Shear makes no mention of a hierarchy of modules as recited by Assignee's claim 5. Furthermore, the cited portion of does not teach or suggest "the non-leaf module is equipped to verify the immediate downstream module as not having been compromised." In light of this, it is respectfully asserted that the Examiner has failed to establish a prima facie case of unpatentability under 35 USC § 103 because the cited document, alone or in combination do not teach every element of

Assignee's claim 5. Therefore, Assignee respectfully requests that this ground for rejection be withdrawn.

With regard to claim 6, Assignee respectfully asserts that the portion of Shear cited by the Examiner does not teach or suggest an apparatus "wherein the non-leaf modules is equipped to verify the immediate downstream module as not having been compromised, at least during initialization," as recited by Assignee's claim 6. For example, the portion of Shear cited by the Examiner states "Appliances assigned to a particular assurance levels can protect themselves from executing load modules or other executables associated with different assurance levels." Shear makes no mention of a module verifying "the immediate downstream module as not having been compromised, at least during initialization," as recited by Assignee's claim 6. In light of this, it is respectfully asserted that the Examiner has failed to establish a prima facie case of unpatentability under 35 USC § 103 because the cited document, alone or in combination do not teach every element of Assignee's claim 6. Therefore, Assignee respectfully requests that this ground for rejection be withdrawn.

With regard to claim 7, Assignee respectfully asserts that the cited documents, alone or in combination, do not teach or suggest an apparatus "wherein the non-leaf modules is equipped to further verify the immediate downstream module remains un-compromised before each transfer of recovered digital content to the immediate downstream module," as recited by Assignee's claim 7. Specifically, Shear, which the Examiner cites for teaching this element does not teach or suggest a module "to further verify the immediate downstream module re-mains un-compromised before each transfer of recovered digital content." Furthermore, the Examiner does not even cite to a portion of Shear for this teaching. Absent an indication by the Examiner as to what portion of Shear teaches recited portion of Assignee's claim 7, it is respectfully asserted

that this rejection has been traversed. In light of this, Assignee respectfully requests that this ground for rejection be withdrawn.

With regard to claim 11, the cited documents, alone or in combination, do not teach or suggest an apparatus "wherein a first subset of the plain text digital content rendering modules are member modules of a first application domain, and a second subset of the plain text digital content rendering modules are member modules of a second application domain," as recited by Assignee's claim 11. Specifically, the Examiner does not cite to any document teaching the recited portion of Assignee's claim 11. The Examiner merely asserts with no supporting documentation that "one of ordinary skill in the art would have been motivated to do this because dividing modules by domain in an easy and convenient method of." Absent any teaching or suggestion in the cited documents or knowledge of one skilled in the art, it is respectfully asserted that the Examiner has failed to establish a prima facie case of unpatentability under 35 USC § 103 with respect to Assignee's claim 11. Therefore, Assignee respectfully requests that the Examiner withdraw this rejection.

Additionally, contrary to the Examiner's asserted position, there is no motivation found in any of the cited documents to combine reference teachings. The Examiner merely asserts that one of ordinary skill would have found the respective combinations obvious without citing a motivation in the cited documents or knowledge of one skilled in the relevant art as motivation for the respective combinations. For example, with regard to the combination of Horstmann and Amino, the Examiner asserts without citing to any support that "one of ordinary skill would have been motivated to do this." Assignee respectfully asserts that this is insufficient to establish a motivation to combine the cited documents. For further example, with regard to the combination of Horstmann, in view of Amino, in further view of Shear, The Examiner states that "one of ordinary skill in the art would have been motivated to do this because defective, bogus and

unauthorized computer information can wreak havoc within an electronic system" and cites to a portion of shear to support this position. However, it is unclear based on the cited portion of Shear what the motivation to combine the Shear's asserted teaching relating to set top boxes and home media players with Hosrtmann's asserted teaching relating to a software security mechanism, and Amino's asserted teaching relating to digital rights protection. In light of this, it is respectfully asserted that the examiner has failed to establish a proper motivation to combine the asserted teaching of the cited documents.

Furthermore, Assignee respectfully asserts that the Examiner has performed "hindsight construction", which the Federal Circuit has made clear is not appropriate. As stated in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227, USPQ 543 (Fed. Cir 1985), "It is error to reconstruct the patentees claimed invention from the prior art by using the patentee's claim as a 'blueprint'. When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself." Here, based on the combination of cited documents relating to a "Software Security Mechanism", "Systems and Methods Using Cryptography," a "Method for Securely Distributing a Conditional Use Private Key," and a news article relating to digital rights protection, it appears that the Examiner used the pending claims as a blueprint to combine the various references. In light of this, Assignee respectfully asserts that the Examiner's rejections under 35 USC § 103 has been traversed.

In addition, Assignee respectfully asserts that new claims 33-42 likewise patentably distinguish from the documents cited by the Examiner for reasons similar and/or the same as those presented above.

For at least the reasons above, Assignee respectfully submits that claims 1-42 are allowable and requests that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the foregoing is believed sufficient to address the Examiner's rejections. Likewise, failure of the Assignee to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead it is believed that the Examiner's positions are rendered moot by the foregoing and, therefore, it is believed not necessary to respond to every position taken by the Examiner with which Assignee does not agree.

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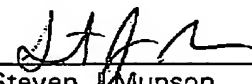
OCT 16 2006

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500. Consideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3130.

Respectfully submitted,

Dated: 10-16-06
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